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On May 23, 2002

TOWNSEND and TOWNSEND and CREW LLP

By: Jay M. Marshall

PATENT
Attorney Docket No.: 018501-005000US
Client Ref. No.: BRCA 016 US



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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Gish, et al.

Application No.: 09/747,371

Filed: December 21, 2000

For: NOVEL METHODS OF
DIAGNOSING BREAST CANCER,
COMPOSITIONS, AND METHODS OF
SCREENING FOR BREAST CANCER
MODULATORS

Examiner: Johannsen, Diana B

Art Unit: 1641

**AMENDMENT AND RESPONSE TO
RESTRICTION REQUIREMENT**

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

In response to the Office Action mailed March 27, 2001, please amend the above identified application as follows. Enclosed is a Petition to Extend Time for one month, from April 27, 2002, to May 27, 2002:

IN THE CLAIMS:

Please cancel claim 7 without prejudice to subsequent revival and add new claims 32-38 as follows:

B1
32. A method for determining the presence or absence of a breast cancer cell in a patient, the method comprising detecting a nucleic acid comprising a

sequence at least 75% identical to SEQ ID NO:1 in a sample from the patient, thereby determining the presence or absence of the breast cancer cell.

33. The method of claim 32, wherein the sample comprises isolated nucleic acids.

34. The method of claim 33, wherein the nucleic acids are mRNA.

35. The method of claim 32, wherein the sample is breast tissue.

36. The method of claim 32, wherein the nucleic acid is SEQ ID NO:1.

37. The method of claim 32, wherein said detecting step further comprises using a labeled nucleic acid probe.

38. The method of claim 32, wherein said detecting step further comprises utilizing a biochip comprising a sequence at least 75% identical to SEQ ID NO:1.

REMARKS

In response to the Office Action mailed March 27, 2002, Applicants elect with traverse to prosecute the claims of Group V, new claims 32-38.

According to the MPEP, where claims can be examined together without undue burden, the Examiner must examine the claims on the merits even though they are directed to independent and distinct inventions. See, the MPEP at 803.01. In establishing that an "undue burden" would exist for co-examination of claims, the Examiner must show that examination of the claims would involve substantially different prior art searches, making the co-examination burdensome. To show undue burden

resulting from searching difficulties, the Examiner must show that the restricted groups have a separate classification, acquired a separate status in the art, or that searching would require different fields of search (MPEP at § 808.02). Applicants respectfully submit that all of the inventions in the present application can readily be searched without undue burden. As such, at the very least, Applicants request that the Examiner join Groups V and XIV because a search for one of the groups will identify art pertaining to the other.

In addition, to claim the subject matter of the invention more particularly, claim 7 has been canceled and new claims 32-38 have been added. Claims 32-38 are drawn to methods of detecting a breast cancer cell (group V). Claims 32-38 add no new matter. These claims all find support in the originally filed claims and in the specification. In particular claims 32-38 find support in original claim 7 and in the specification on page 8, lines 27-35; page 12, lines 10-25; page 15, lines 4-17, page 32, lines 28-35; and page 33, lines 1-17.

If a telephone call would expedite prosecution of this application, the Examiner is invited to telephone the undersigned at 415-576-0200.

Respectfully submitted,



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